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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lap-Wai Chow ✓

Application No: 09/768,911 ✓

Filed: January 24, 2001 ✓

For: "Integrated Circuit Protection Against  
Reverse Engineering Using Vias..."

Examiner: David A. Zarneke Art No.: 2827 #14

**RESPONSE**

Our Ref: 618027-2/RPB B-3962

Your Ref: HRL 000309

Date: November 5, 2002

*Response  
J. McMillan  
11/19/02*

Honorable Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Dear Sir:

This paper is filed in response to the official action dated August 14, 2002.

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REMARKS

**ELECTION/RESTRICTION REQUIREMENT**

In the official action the Examiner asserts that the applicant made an admission in an interview summary which was attached to the official action. With all due respect to the Examiner, the undersigned has reviewed the interview summary which was attached to the official action and neither the word "admission" nor the words which the Examiner quotes, namely, "first", "second", "upper" and "lower" appear in the interview summary. Moreover, it is noted that the interview summary purports to reflect a telephone conversation which the undersigned had with the Examiner's supervisor, David L. Talbot. Mr. Talbot's signature does not appear on the interview summary but rather it has been stamped by a Mr. Cuneo, who did not attend the interview. How could Examiner Cuneo sign off on an interview summary if he did not attend the interview?

Furthermore, to make the record clear, when the undersigned discussed this matter with Examiner Talbot, it was in terms of the official action dated May 28, 2002 which the undersigned felt was wrongfully issued and which the undersigned felt makes a statement which is incorrect. Therefore, the undersigned telephoned Mr. Talbot who signed the official action. The official action dated May 28, 2002 asserts that the prior response was not fully responsive to the prior official action because "applicant is required to list all claims that are elected." The undersigned brought Mr. Talbot's attention to the fact that the applicant clearly elected claims 1-8, 17 and 19-21 for examination in this application by the prior response. Since the Examiner was setting forth an

election of species requirement, the applicants provisionally elected the species of Figure 2(b). Attached hereto is a copy of the response filed on April 11, 2002. That prior response was fully responsive to the official action and the Examiner's subsequent assertion that the applicant did not elect claims in that response was clearly incorrect.

The undersigned advised Examiner Talbot that if the Examiner disagrees with the applicants' election of claims, the Examiner is free to take a position which is contrary to the position taken by applicants. But since the applicants identified the species by identifying the figure which the applicants wished to have examined, namely Figure 2(b), the applicants' response was fully responsive to the prior official action. Thus, the Examiner's assertion in the official action dated May 28, 2002 that the applicants' prior response was not fully responsive to the official action was incorrect. Examiner Talbot, upon reviewing the file, agreed and indicated that official action would be withdrawn.

With respect to the interview summary which is attached to the current official action, which purports to be an interview summary of the discussion between the undersigned and SPE Talbot, the discussion was in terms of an election of species, namely, a species disclosed in the patent application, and the species which was discussed was the species of Figure 2(b). The undersigned believes that there was no particular discussion of claim 21. Therefore the reference to claim 21 in the interview summary appears to be an erroneous reference. Instead of claim 21, the undersigned repeated the election of the species of Figure 2(b).

With all due respect, an election of claim 21 in response to an election of species requirement makes no sense. But the election of a figure in response to a species objection does make sense.

### **THE PRIOR ART REJECTION**

In the official action the Examiner rejects the claims active in this application as allegedly being either anticipated by or obvious over EP 1,193,758.

EP1,193,758 was published on April 3, 2002. This application enjoys a filing date of January 24, 2001. EP 1,193,758 is not prior art to this application. The Examiner cites 35 U.S.C. 102(e) in the official action. The cited document is a European Patent application and not an "international application filed under the treaty referred to in section 351(a)", nor was it filed based on a US application. Since EP 1,193,758 is not prior art to this application, there is no need to respond to the Examiner's rejections. The Examiner can not rely upon EP 1,193,758 in rejecting the claims in

this application.

Reconsideration of this application as amended is respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C., 20231 on

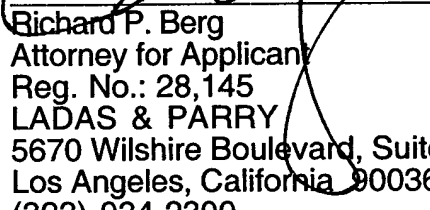
November 5, 2002  
(Date of Deposit)

Corinda Humphrey  
(Name of Person Signing)

  
(Signature)

November 5, 2002  
(Date)

Respectfully submitted,

  
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RPB:CH

Enclosures: copy of response filed April 11, 2002



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lap Wai Chow, et al.

) Group Art No.: 2812

) Examiner: David A. Zarneke

Application No: 09/768,911

) **RESPONSE**

Filed: January 24, 2001

) Our Ref: B-3962 618027-2/RPB

For: "INTEGRATED CIRCUITS PROTECTED..." ) Date: April 11, 2002

Honorable Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**FILE**

Dear Sir:

This paper is filed in Response to the Official Action dated March 27, 2002. In the Official Action the Examiner asserts that there are two species disclosed in the Patent Application, namely the species of Figure 2(a) and the species of Figure 2(b). The Examiner has requested that we elect a single disclosed species for examination on the merits and to advise the Examiner of which claims are readable on that species.

The Examiner asserts that currently claims 1-8, 17 and 19 are generic to the two species. While the Applicant agrees that those claims are generic to the two species, the Applicants also believe that claims 20 and 21 active in this Application are generic.

Inasmuch as the Applicants have previously elected the product claims, namely claims 1-8, 17 and 19-21 for examination in this Application, and given the fact that all those claims are generic to the two species identified by the Examiner, it is submitted that the election of species requirement is improper and should be withdrawn. Nevertheless, in order to ensure that this Response is considered to be fully responsive to the Examiner's request, the Applicants provisionally elect the species of Figure 2(b) for examination.

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Response

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April 11, 2002  
(Date of Deposit)

\_\_\_\_\_  
RICHARD P. BERG  
(Name of Applicant, Assignee  
or Registered Representative)

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
April 11, 2002  
(Date)

Respectfully submitted,

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